

ESTTA Tracking number: **ESTTA375722**

Filing date: **10/28/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052531
Party	Defendant Angel Playing Cards Co., Ltd.
Correspondence Address	ANGEL PLAYING CARDS CO., LTD. 10-1 KAWARAYAMACHI 2-CHOME CHUO-KU OSAKA, JAPAN
Submission	Answer
Filer's Name	Holly Pekowsky
Filer's e-mail	ptodocket@arelaw.com
Signature	/Holly Pekowsky/
Date	10/28/2010
Attachments	Answer to Amended Petition for Canc - 531 Canc.pdf (24 pages)(2844868 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

----- x		
THE UNITED STATES PLAYING CARD COMPANY,	:	
	:	Cancellation No. 92052531
	:	
Petitioner/Counterclaim	:	
Registrant,	:	
	:	
v.	:	
	:	
ANGEL PLAYING CARDS CO., LTD.,	:	
	:	
Registrant/Counterclaim	:	
Petitioner.	:	
----- x		

**ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM
TO AMENDED PETITION FOR CANCELLATION**

Registrant/Counterclaim Petitioner Angel Playing Cards Co., Ltd. (“Angel”), through its attorneys Amster, Rothstein & Ebenstein LLP, answers the Amended Petition for Cancellation filed by Petitioner The United States Playing Card Company (“PCC”), as follows:

1. Angel admits the allegations contained in Paragraph 1 of the Amended Petition for Cancellation.
2. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Amended Petition for Cancellation, and, accordingly, denies the same.
3. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Amended Petition for Cancellation, and, accordingly, denies the same.

4. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Amended Petition for Cancellation, and, accordingly, denies the same.

5. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Amended Petition for Cancellation, and, accordingly, denies the same.

6. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Amended Petition for Cancellation, and, accordingly, denies the same.

7. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 of the Amended Petition for Cancellation, and, accordingly, denies the same.

8. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Amended Petition for Cancellation, and, accordingly, denies the same.

9. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Amended Petition for Cancellation, and, accordingly, denies the same.

10. Angel denies the allegations contained in Paragraph 10 of the Amended Petition for Cancellation.

11. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 11 of the Amended Petition for Cancellation, and, accordingly, denies the same.

12. Angel lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Amended Petition for Cancellation, and, accordingly, denies the same.

13. Angel denies the allegations contained in Paragraph 13 of the Amended Petition for Cancellation.

14. Angel denies the allegations contained in Paragraph 14 of the Amended Petition for Cancellation.

15. Angel denies the allegations contained in Paragraph 15 of the Amended Petition for Cancellation.

16. Angel denies the allegations contained in Paragraph 16 of the Amended Petition for Cancellation.

AFFIRMATIVE DEFENSES

17. There is no likelihood of confusion between Angel's marks of Registration Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673 ("Angel's Marks") and the marks asserted by PCC in the Amended Cancellation ("PCC's Marks") since the marks are sufficiently distinguishable to avoid confusion.

18. There is no likelihood of confusion or dilution between Angel's Marks and PCC's Marks since PCC's Marks are weak, as evidenced by extensive third party use of similar designs on playing cards, including, without limitation, Modiano of Italy (*see* attached Exhibit A), Dal Negro (*see* Exhibit B), Copag Brasil (*see* attached Exhibit C), GMZ Associates, Ltd. (*see* attached Exhibit D), Gemaco Playing Card Co. (*see* attached Exhibit E), Kuo Kau Paper Products Co. (*see* attached Exhibit F), Carta Mundi (*see* attached Exhibit G), Playing Cards R Us Inc., Nintendo (*see* attached Exhibit H), Copag Da Amazonia S/A (*see* attached Exhibit I), a not-yet-identified third party whose cards were found at a casino in the U.S. (*see* attached Exhibit J),

Gaming Partners International Corp. (*see* attached Exhibit K), and Heartland Consumer Products, LLC (*see* attached Exhibit L).

19. Upon information and belief, PCC's claims must fail since PCC is relying on several different variations of the Marks - including the newly asserted Aristocrat and design mark.

20. Upon information and belief, PCC's claim for dilution must fail since PCC's Marks are not famous.

21. PCC's claims must fail since it has not alleged and could not establish that PCC's Marks constitute a family of marks as that term is defined under relevant trademark law, including, without limitation that there is no common element shared by all of Opposer's Marks.

22. PCC's claim for falsely suggesting a connection with PCC must fail because PCC is not a person, institution, belief or national symbol within the meaning of this section of the Lanham Act.

23. PCC's claim for falsely suggesting a connection with PCC must fail since Angel's Marks is not the same as, or a close approximation of, PCC/PCC's Marks; nor would it be recognized as such.

24. PCC's claim for falsely suggesting a connection with PCC must fail since PCC/PCC's Marks do not point uniquely and unmistakably to PCC.

25. Upon information and belief, PCC's claim for falsely suggesting a connection with PCC must fail since the fame or reputation of the person or institution is not such that, when the mark is used with the Angel's goods or services, a connection with the person or institution would be presumed.

* * *

WHEREFORE, Angel requests that this Amended Cancellation be denied and that registration be granted.

COUNTERCLAIM TO CANCEL REGISTRATION NO. 48763

Registrant/Counterclaim Petitioner Angel Co., Ltd. (“Angel”) by and through its attorneys, hereby counterclaims seeking cancellation of U.S. Trademark Registration No. 48,763 registered January 9, 1906 and owned by Opposer/Counterclaim Registrant The United States Playing Card Company (“PCC”).

The grounds for cancellation are as follows:

Background Facts

26. Angel incorporates each and every response of the foregoing answer and affirmative defenses into this counterclaim as though fully set forth herein.

27. Angel is a corporation organized and existing under the laws of Japan, having a place of business at 10-1 Kawarayamachi 2-Chome, Chuo-ku Osaka Japan.

28. On or about June 7, 2010, PCC commenced the instant Cancellation seeking to cancel Angel’s Registration Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673 for the design marks shown therein for playing cards (the “Cancellation”).

29. In the Cancellation, PCC asserted, among others, U.S. Trademark Registration No. 48,763 for the design shown and described in the copy of the Registration shown in Exhibit K (“PCC’s Mark”) for playing cards (the “Subject Registration”). Specifically, PCC alleged that Angel’s marks which are the subject of Registration Nos. 3,759,470, 3,759,471, 3,759,472 and 3,791,673 (collectively “Angel’s Marks”) should be canceled since confusion and dilution is likely between Angel’s Marks and PCC’s Mark.

30. Angel has standing to bring the instant counterclaim to cancel the Subject Registration since PCC has asserted the Subject Registration against Angel in the Cancellation. *See* T.B.M.P. § 309.03(b) (“a counterclaimant’s standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding.”).

31. PCC’s Mark is described on the face of the Subject Registration as follows:

the trade-mark consists of a design many times repeated upon a panel or parallelogram to give the effect of many parallel diagonal lines crossing each other and inclosing dark diamond-shaped figures. the appearance of the light lines is gained by four light parallel strokes or lines at each side of the dark diamond, and at each corner of each dark diamond a smaller light diamond space appears the effect resembling a plaid design.

32. Upon information and belief, PCC has abandoned PCC’s Mark.

33. Specifically, although the Subject Registration describes PCC’s Mark as having “four light parallel strokes or lines” (*see* Par. 32 above), the specimens of use submitted in connection with the maintenance of the Subject Registration in 1945, 1965, 1971, 1985 and 2006 contain only three strokes.

34. Upon information and belief, PCC has used a mark with three strokes, rather than four strokes, for many years.

35. The difference between PCC’s Mark (*i.e.*, a mark with four strokes) and the mark shown in the specimens of use referenced above (*i.e.*, a mark with three strokes) constitutes a material alteration of PCC’s Mark.

36. Upon information and belief, PCC has discontinued use of PCC’s Mark with the intent not to resume such use.

37. Upon information and belief, PCC has abandoned PCC’s Mark.

38. Upon information and belief, as a result of said abandonment, PCC's Mark has lost all capacity as a source indicator for playing cards.

39. Since there is a contention by PCC in the Cancellation that there is a likelihood of confusion between Angel's Mark and PCC's Mark, then the continued existence of Subject Registration on the Principal Register has damaged and will continue to damage Angel. The continued existence on the Principal Register of the Subject Registration is being used by PCC against Angel in the Cancellation and may prevent Angel from obtaining a registration for its Mark.

For at least the reasons stated herein, the continued registration of the Subject Registration would in all likelihood be damaging to Angel.

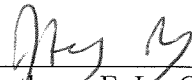
* * *

Based on all of the foregoing, the Subject Registration should be canceled.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Angel Playing Cards Co., Ltd.
90 Park Avenue
New York, New York 10016
(212) 336-8000

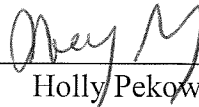
Dated: New York, New York
October 28 2010

By: 
Anthony F. Lo Cicero
Holly Pekowsky

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Registrant/Counterclaim Petitioner Angel Playing Cards Co., Ltd in the above-captioned Cancellation proceeding and that on the date which appears below, she caused a copy of the foregoing ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM TO AMENDED PETITION FOR CANCELLATION to be served on the attorneys for Petitioner/Counterclaim Registrant, The United States Playing Card Company, by first class mail by causing a copy thereof to be placed in a depository under the care and custody of the United States Postal Service, in the State of New York, postage pre-paid, in a wrapper addressed as follows:

Stuart Dunwoody, Esq.
DAVIS WRIGHT TREMAINE LLP
1201 Third Avenue, Suite 2200
Seattle, WA 98101



Holly Pekowsky

Dated: New York, New York
October 28, 2010

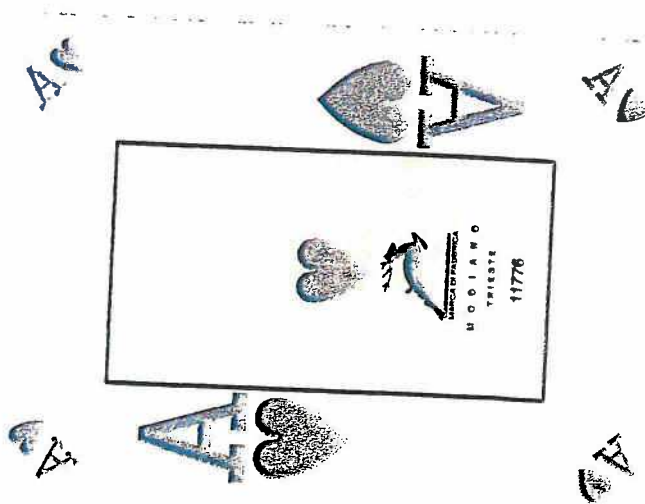
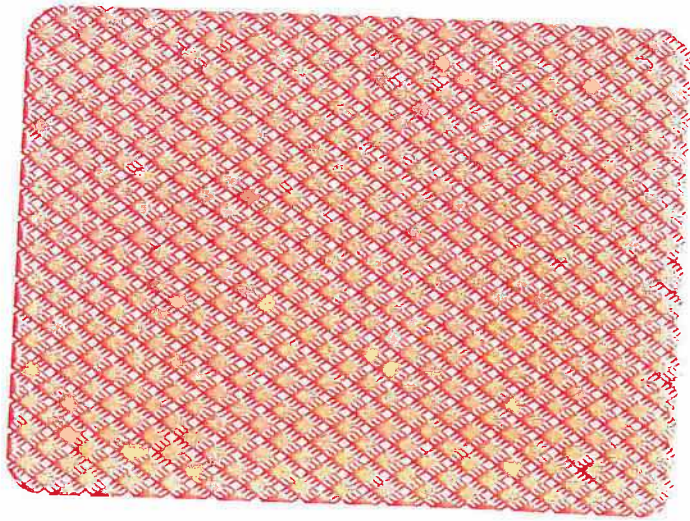


EXHIBIT A

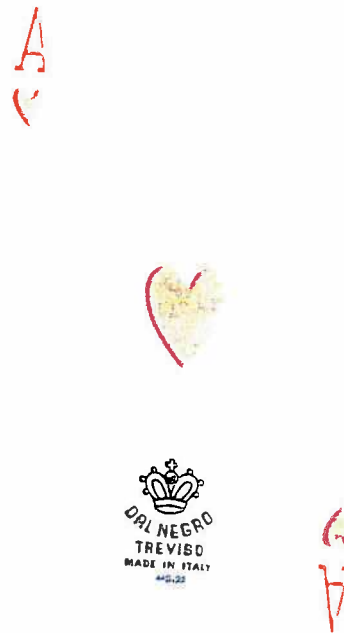
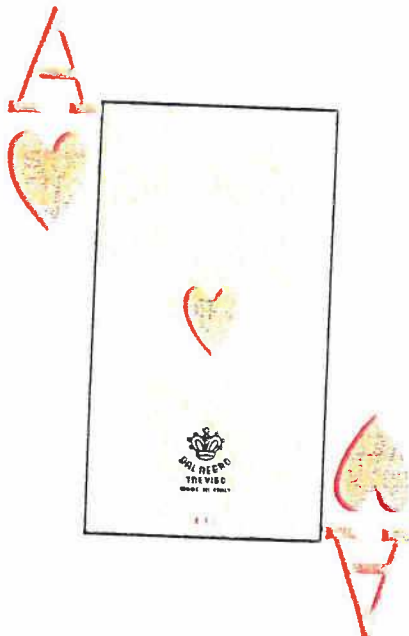
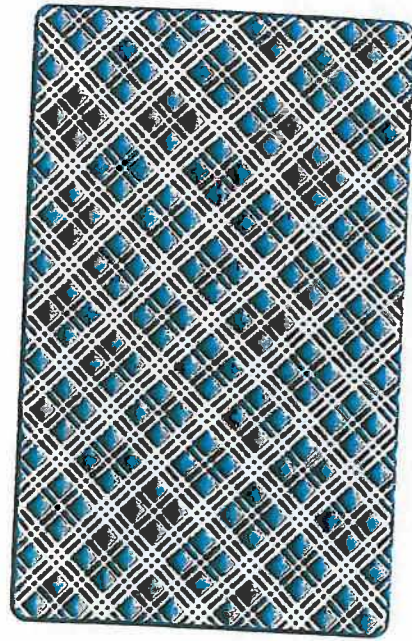
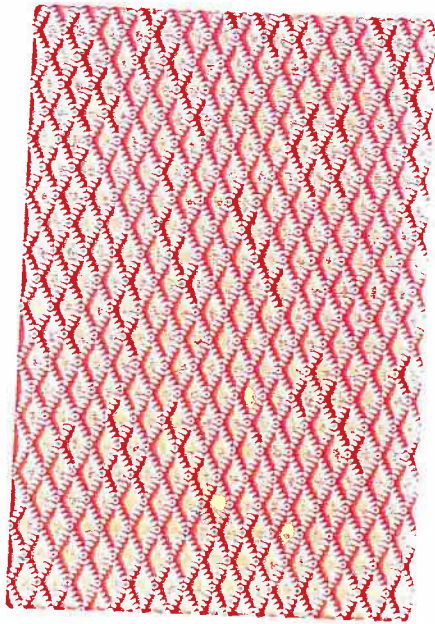


EXHIBIT B

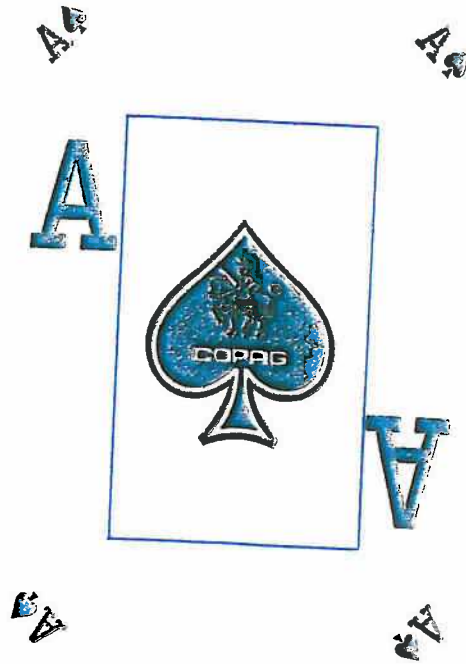
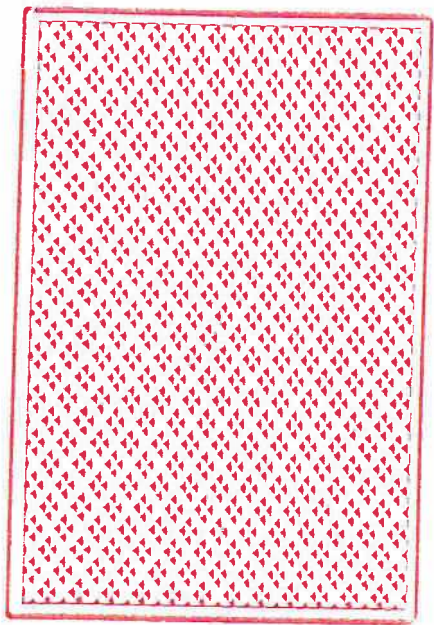
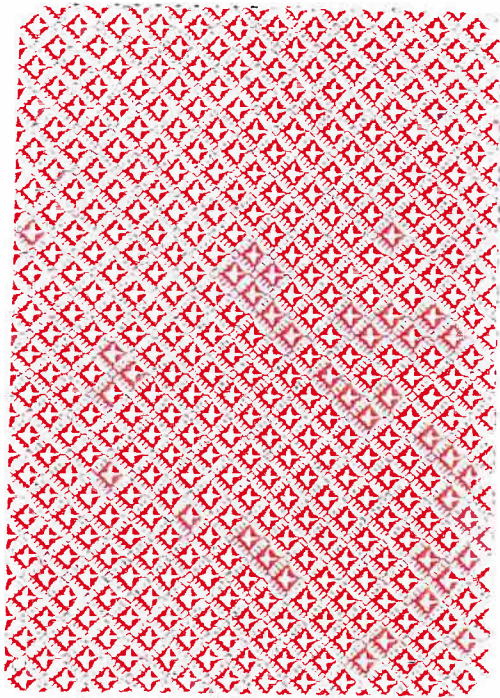


EXHIBIT C



J
O
K
E
R



J
O
K
E
R



GMZ Associates, Ltd.
Brentwood, NY 11717
Tel: (631) 273-5088 Fax: (631) 273-0617

EXHIBIT D

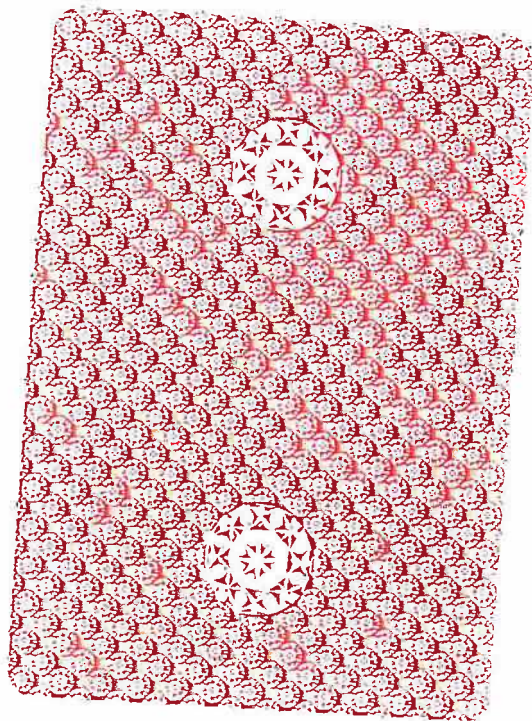


EXHIBIT E

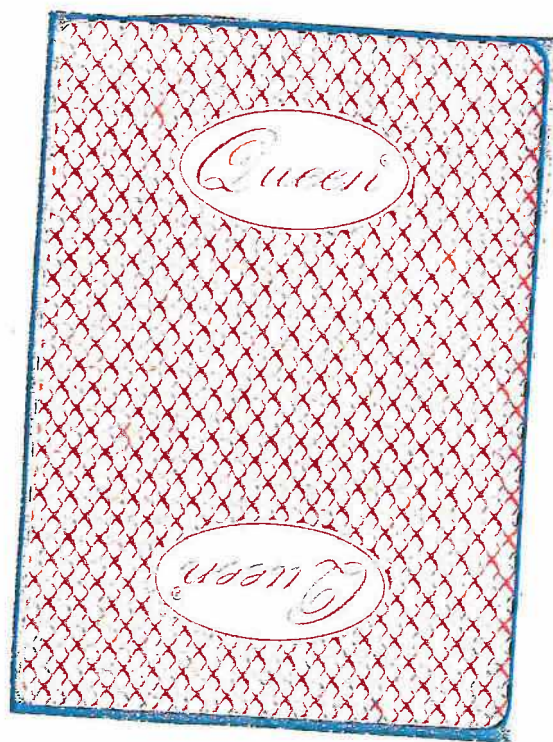


EXHIBIT F

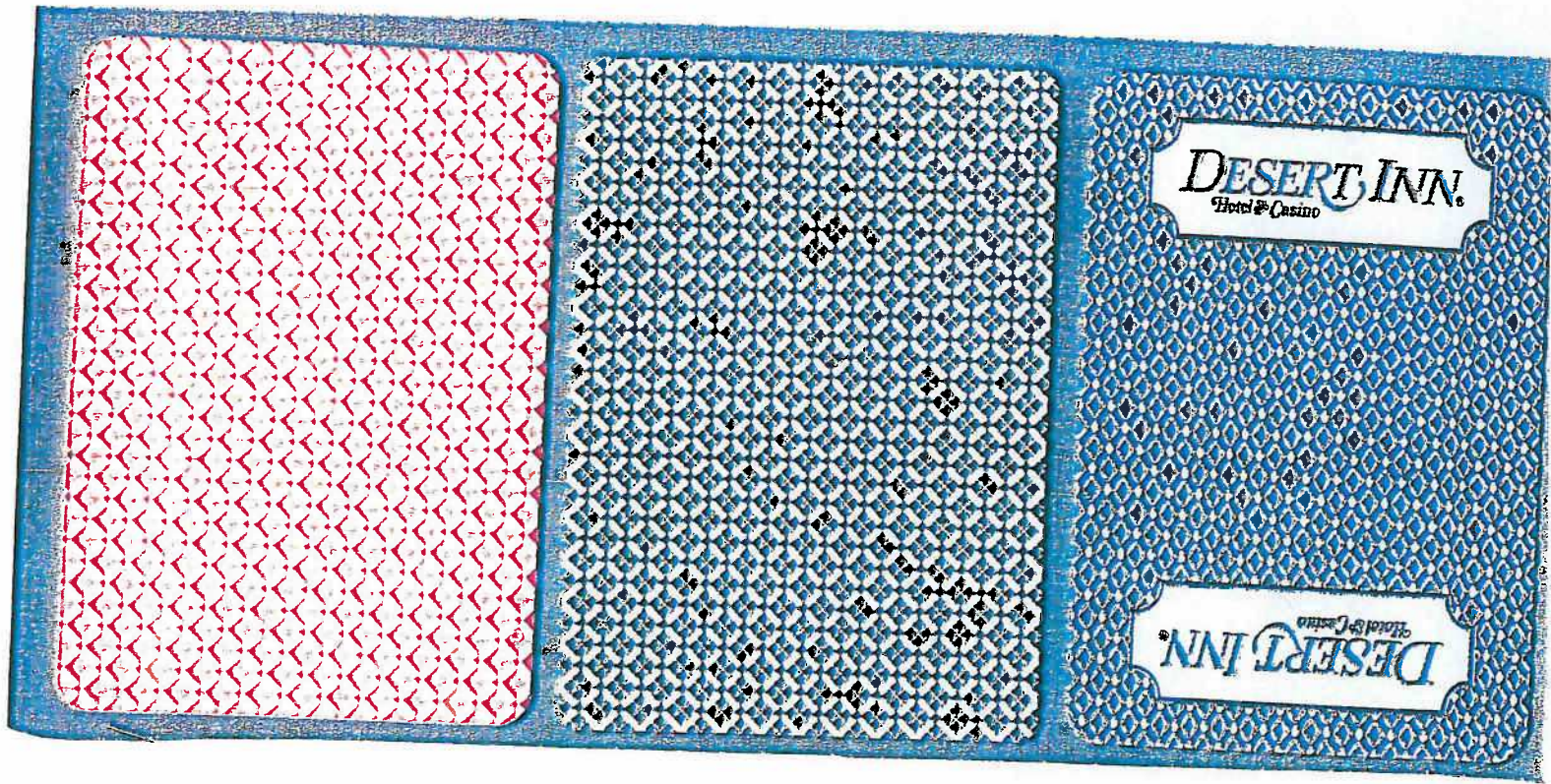


EXHIBIT G

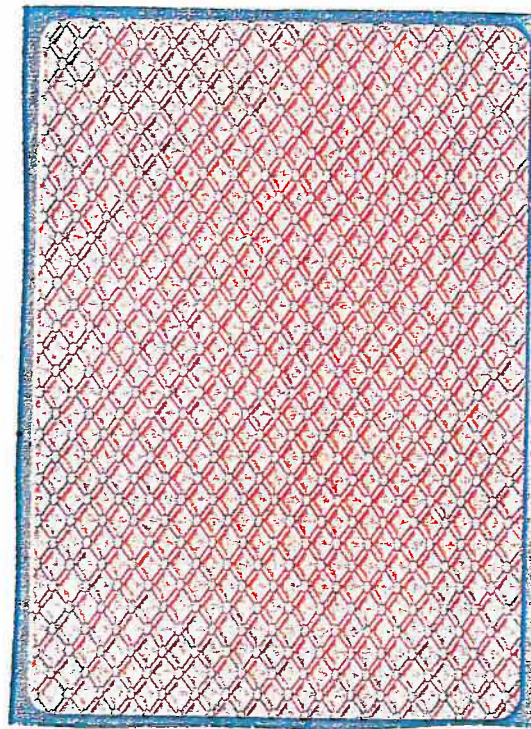


EXHIBIT H



EXHIBIT I

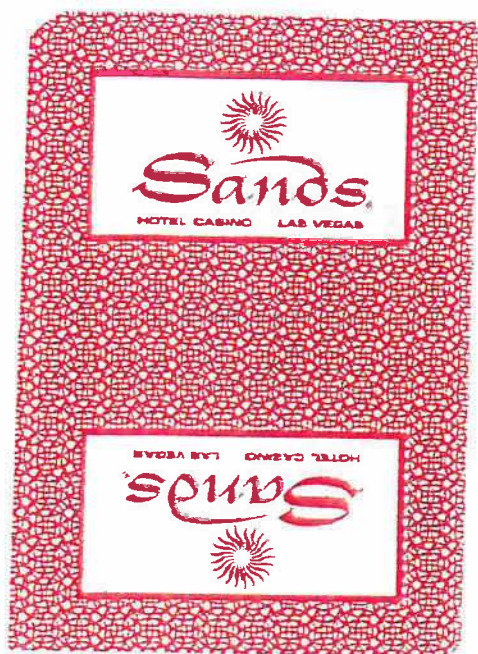
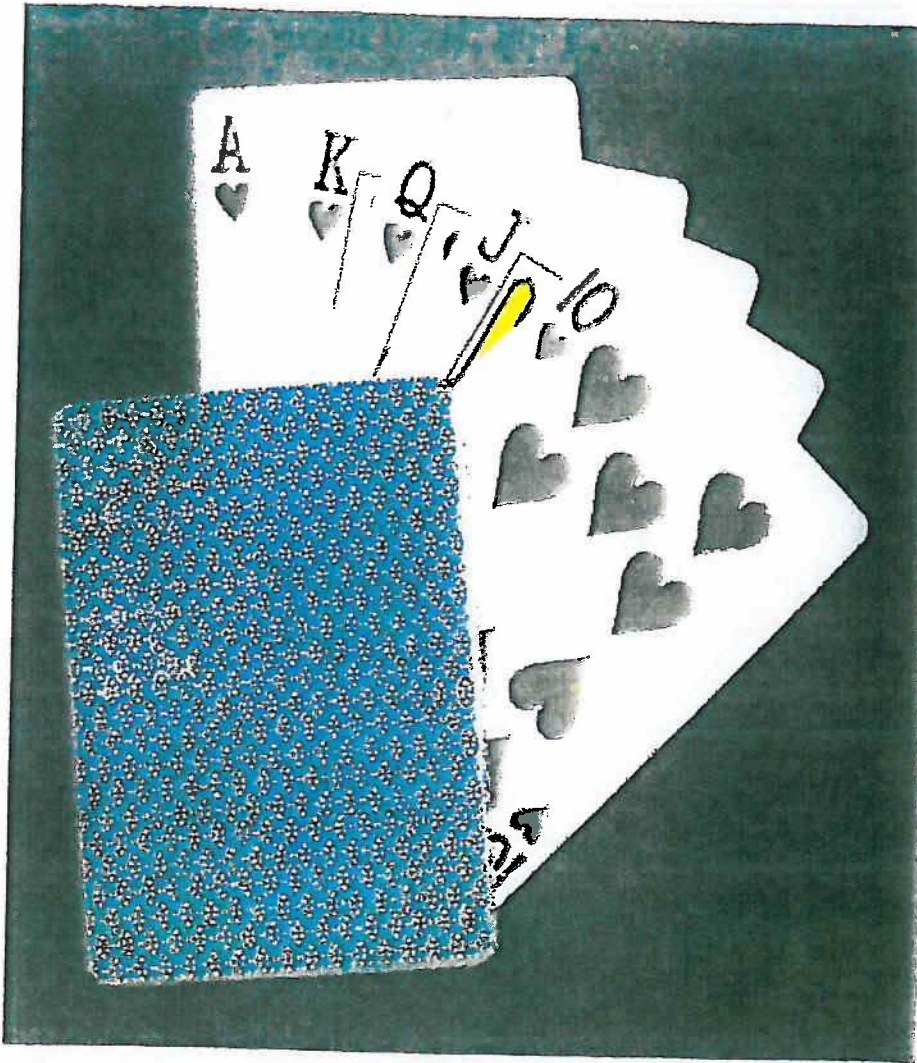


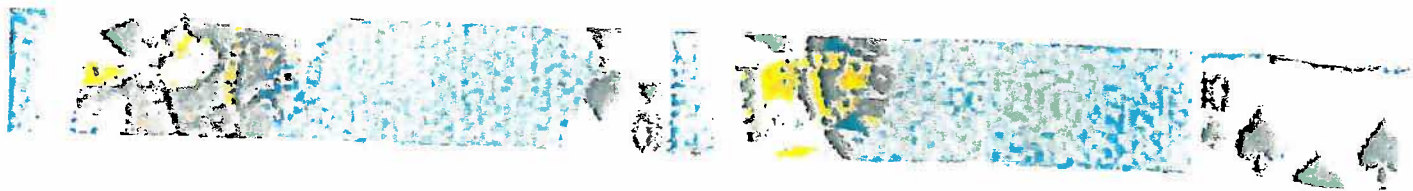
EXHIBIT J

GAMING PARTNERS INTERNATIONAL CORPORATION



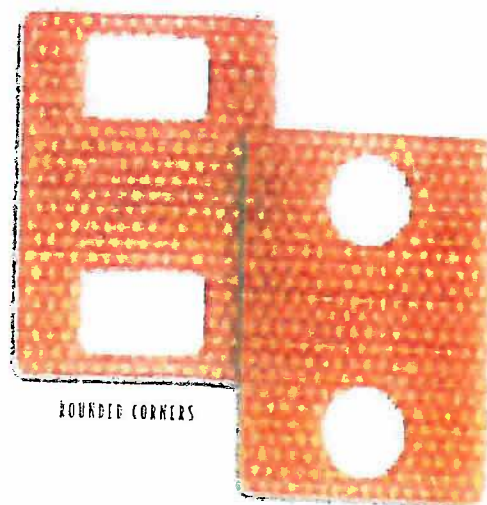
CLOSE WINDOW

EXHIBIT K



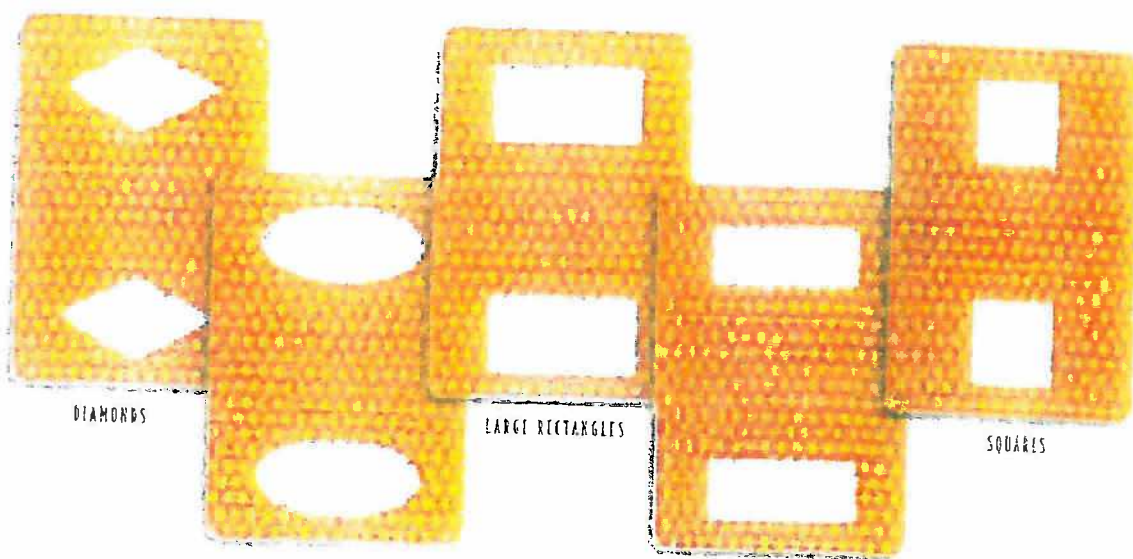
LOGO WINDOWS

Thanks to an experienced art department, GPI® USA can assist casinos in recreating a logo into a single color format, so that it may fit in the logo window. The AD SIDE can be printed in one or more colors, while the logo window can be designed in seven different shapes:



ROUNDED CORNERS

CIRCLES



DIAMONDS

OVALS

LARGE RECTANGLES

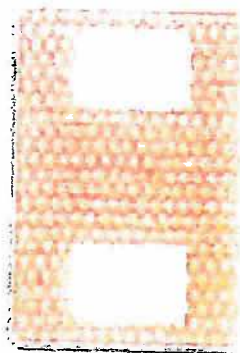
SMALL RECTANGLES

SQUARES

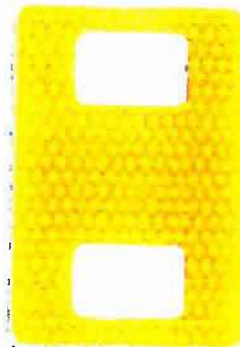


AVAILABLE COLORS

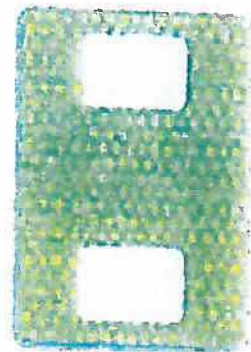
Back designs are available in eight different colors



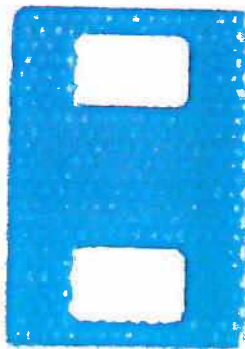
RED



BURNT ORANGE



LIME GREEN



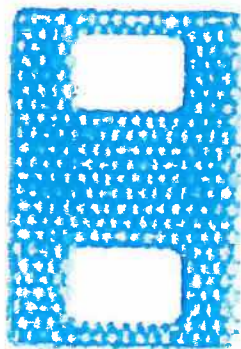
BLUE



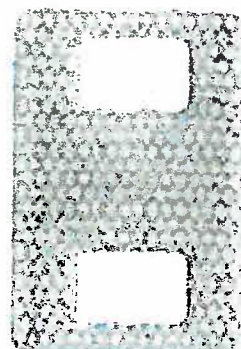
GREEN




PURPLE



TEAL



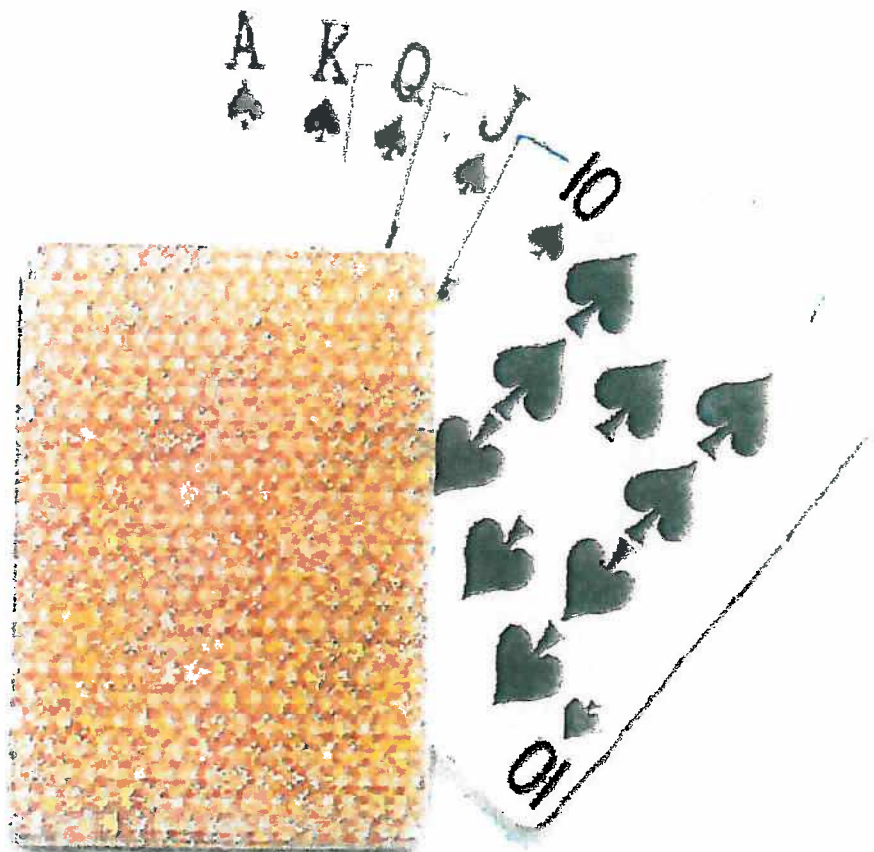
BLACK



PAULSON® PLAYING CARDS

Paulson® playing cards, a brand of Gaming Partners International® USA, a.k.a. GPI® USA, have been manufactured by a highly experienced staff in Mexico for over 15 years. From the selection of the paper, through the printing process to the final product, the highest quality control procedures are followed.

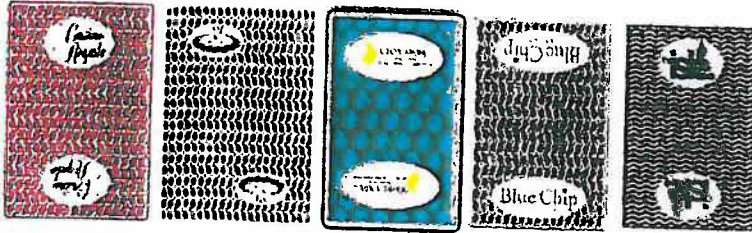
Paulson playing cards are high quality, 100% aqueous coated, 310 grams, and are available in the popular 3.5" x 2.5" size. All Paulson playing cards are compatible with all automatic shufflers. Paulson cards are supplied to major casinos throughout the U.S. and around the world.





Bringing people together...

Casino Sales



Casino Sales

Heartland Consumer Products, LLC is a leading supplier of premium quality casino playing cards.

Our high-quality, casino solution offers the following:

- Custom labeling
- Highest quality playing card stock
- Specially formulated coatings
- Multiple levels of QA inspection
- Global service
- Timely shipping and expedited service

We produce the longest lasting, best shuffling casino playing card in the World. Once you try our products in your casino, you'll join so many others who come back again and again for more of the best!

Our attention to detail is legendary. When you work with Heartland, you will receive over 30 years of playing card experience and a 100% focus on your needs.

Contact Information:

Heartland Consumer Products, LLC

Greg Heslin
EVP Sales and Marketing
417-886-2917
inquiries@heartland-products.com

Matsui Gaming Machine

European Casinos
Matsui Europe LTD.
Unit 11a, Quays reach, Carolina Way
Off South Langworthy rd. Salford, Manchester M50 2ZY, UK
Tel: 44-161-736-9011
dave@matsui-gaming.co.jp

Contact Us: 216.712.4100 or email: inquiries@heartland-products.com

J

JOKER



VEGAS™

P

